UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,882	02/27/2002	Makoto Suzuki	132578-00014	7768

7590 12/21/2004

Arnold B. Silverman
Eckert Seamans Cherin & Mellott, LLC
44th Floor
600 Grant Street
Pittsburgh, PA 15219

EXAMINER	
BECKER, DREW E	

ART UNIT	PAPER NUMBER
1761	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/085,882	SUZUKI ET AL.
	Examiner	Art Unit
	Drew E Becker	1761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,544,569 in view of JP 2000-197456. It would have been obvious to one of ordinary skill in the art to incorporate the triangular pieces of JP 2000-197456 since this would have a convenient means for opening the package.

3. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/353,680 in view of JP 2000-197456. It would have been obvious to one of ordinary skill in the art to incorporate the triangular pieces of JP 2000-197456 since this would have a convenient means for opening the package.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-2 and 6 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2000-197456.

JP 2000-197456 teach a conical sushi package comprising a conical mass of rice (Figure 4, #51), an outer film (Figure 1, #1), an inner film (Figure 1, #2), a sheet of food between the films (Figure 1, #3), the films being heat sealed lines (paragraph 0006; Figure 2), triangular pieces (Figure 1, #12 & 22), rectangular pieces (Figure 1, #11 & 21), and a separable lap having weak adhesion due to an elongated heat sealing line of individual tacks (Figure 1, #13; paragraph 0008).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 4-5 and 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-197456.

JP 2000-197456 teaches the above mentioned components. JP 2000-197456 does not mention heat seal lines along the entire length of the lap and both triangular pieces being on the inner side of the lap. It would have been obvious to one of ordinary skill in the art to provide heat seal lines in the laps since the laps were already sealed via heat seals (paragraph 0006-8), since lines of heat seals were already used by JP 2000-197456 (Figure 2), since it would have been quite simple for one of ordinary skill in the art to apply the heat seal as a continuous line, since a continuous line would have helped prevent seal off the food sheet and thus prevent possible outside contamination, and since a line of heat seals would helped prevent accidental separation due to one of the "spots" (Figure 1, #13) coming loose. It would have been obvious to one of ordinary skill in the art to place both triangular pieces on the inner side of the lap since one of the triangular pieces was already in this position (Figure 3, #12) and since this would have been done during the course of normal experimentation and optimization.

8. Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2000-197456 as applied above, in view of Suzuki [Pat. No. 4,623,568].

JP 2000-197456 teaches the above mentioned components. JP 2000-197456 does not mention incisions. Suzuki teaches a sushi package comprising incisions (Figures 1, #7). It would have been obvious to one of ordinary skill in the art to incorporate the incisions of Suzuki into the invention of JP 2000-197456 since both are directed to sushi packages, since JP 2000-197456 already included a separable seal (Figure 1, #13; paragraph 0008), and since the incisions of Suzuki would have provided a more convenient and effective means of opening (column 1, lines 55-68).

Response to Arguments

9. Applicant's arguments filed October 20, 2004 have been fully considered but they are not persuasive.

Regarding the Double-patenting rejection, applicant argues that none of the references teach incisions. However, neither of the independent claims (1 & 6) require incisions.

Applicant argues that JP 2000-197456 did not teach "an elongated heat sealing line". However, JP 2000-197456 clearly taught a separable lap having weak adhesion due to an elongated heat sealing line of individual tacks (Figure 1, #13; paragraph 0008).

Applicant argues that one of ordinary skill in the art would not have used a continuous heat seal line with the invention of JP 2000-197456. However, it would have been obvious to one of ordinary skill in the art to provide heat seal lines in the laps since the laps were already sealed via heat seals (paragraph 0006-8), since lines of heat seals were already used by JP 2000-197456 (Figure 2), since it would have been quite simple for one of ordinary skill in the art to apply the heat seal as a continuous line, since a continuous line would have helped prevent seal off the food sheet and thus prevent possible outside contamination, and since a line of heat seals would helped prevent accidental separation due to one of the "spots" (Figure 1, #13) coming loose.

Applicant argues that claims 4 and 8 require incisions. However, this limitation is only found in claims 3 and 7.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, JP 2000-197456 is directed to a sushi package with a separable portion. Suzuki is directed to a sushi package with a separable portion provided by a line of incisions. It would have been obvious to one of ordinary skill in the art to incorporate the incisions of Suzuki into the invention of JP 2000-197456 since both are directed to sushi packages, since JP 2000-197456 already included a separable seal (Figure 1, #13; paragraph 0008), and since the incisions of Suzuki would have provided a more convenient and effective means of opening (column 1, lines 55-68).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Drew Becker
DREW BECKER
PRIMARY EXAMINER
12-16-04